UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/626,600	04/02/1996	MICHAEL F. QUINN	107040.007	8034

27510	7590	02/27/2004

KILPATRICK STOCKTON LLP
607 14TH STREET, N.W.
SUITE 900
WASHINGTON, DC 20005

EXAMINER
POINVIL, FRANTZY

ART UNIT	PAPER NUMBER
3628	

DATE MAILED: 02/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *01 December 2003*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *33-43* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *33-43* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1.   Regarding the status of the claims in the instant application, the Examiner has found new

prior art. The Examiner is obliged to apply the newly found prior art. Thus, the finality of the

prior Office action has been withdrawn and a new rejection follows. The Examiner regrets the

delayed process of the application. Accordingly, claims 33-43 remain pending in the

application. Claims 1-32 are canceled.

2.   In view of the Appeal Brief filed on 12/01/2003, PROSECUTION IS HEREBY

REOPENED. A rejection is set forth below.

> To avoid abandonment of the application, appellant must exercise one of the following two options:

> (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office

action is final); or,

> (2) request reinstatement of the appeal.

> If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no

new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

Claims 33-37, 39-41 and 43 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Cukor and Reding in further view of Seto et al (6,157,914).

Features recited in the instant claims were addressed in the prior Office actions,

BAPI decision and the Examiner's Answer. Applicant is referred to these prior actions.

Applicant argues that the Board and the Examiner fail to consider arguments that

distinguished the present invention over the cited prior art because it was determined

that these points of distinction were not specifically recited in the claims. Applicant has

cited page 12, first full paragraph of the BPAI Decision. Applicants then amend the

claims to recite the capacity of local memories and the process of determining if a

requested document is stored locally before requesting the data from a central site.

In response, applicant's arguments that Cukor does not provide sufficient memory for

storing documents or for long term storing is not persuasive. Cukor clearly teaches a

storage for storing documents. There are no such assertation in Cukor itself of the size

of their memory capacity. Absent a teaching is not an indication that a feature is non-

obvious. Applicant is reminded that:

In re Bozek, 163 USPQ 545 (CCPA 1969) "Reference disclosure must be

evaluated for all that it fairly suggests and not only for what is indicated as preferred." *In*

re Jacoby, 135 USPQ 317 (CCPA 1962) "Problem cannot be approached on basis that

workers in the art would know only what they could read in references; those skilled in

radiator art must be presumed to know something about radiators apart from what

references disclose" "it is immaterial that reference does not disclose specific function

set forth in applicant's specification, since this is merely an additional attribute

possessed by reference structure which would be obvious to one skilled in the art in a

use which one skilled in the art, following teachings of prior art, might make of it"

A reference may be relied upon for all that it would have reasonably suggested to one

having ordinary skill in the art, including non-preferred embodiments.

Furthermore, Cukor et al at the time of filing, available memory capacity was

limited. Cukor does not specify the size or scanned documents or the storage capacities

of files or documents. Thus, Cukor would have taken great care in avoiding erasure of

important financial documents in their local memories. See column 6, lines 43-48.

Applicant's statement that "[A]t the beginning of the next day, those documents stored

on the 80 megabytes of memory will presumably be overwritten by that day's

documents" is not stated in Cukor. This unsupported statement made by applicant is not

convincing because Cukor ensures that sufficient memory is available for a particular

day's transaction. Moreover, Cukor states that "the remote stations include means 26

for communicating document images and related information back and forth with the

central processing site". (Column 7, second full paragraph).

Thus, overwritten a day's transactions would not have occurred in the system of

Cukor.

As per applicant's argument that Cukor's system does not check to determine if

the requested document is stored locally before requesting the data from the central

processing site because a temporary file is erased the next day is not convincing

because it is not required that the memory is completely full for all transactions

occurring for a given day. Transactions are transmitted to a particular location where all transaction processing can take place.

Furthermore, Seto et al disclose a medical support system wherein a user or client may request medical information which may be stored locally or remotely. Patients' medical information are stored in a local hospital where the patient resides or at a remote location. During a requested patient information, the system checks whether the patient's data is stored in local memory of a hsopital data management system. If not, the system directs the request to a central manager which founds the location of the patient data at another hosptial system. That patient data is transmitted from that another hospital and into the hospital system which has made the request. Applicant is directed to column 5, line 65 to column 7, line 6 and also to claim 1 of Seto et al. It would have been obvious to one of ordinary skill in the art at the time the invention was made to introduce the teachings of Seto et al into the combination of Cukor and Reding in order to faciliate the retrival of information at/from any locations.

4.   Claim 38 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cukor, Reding and Seto et al as applied to claim 33 above, and further in view of Dysart.

Features recited in the instant claims were addressed in the prior Office actions, BAPI and the Examiner's Answer. Applicant is referred to these prior actions. Seto et al has been discussed above. Dysart has been noted to teach imagaeing of financial documents across a network in which the scanned images are transferred electronically to regional processing centers at night (see Dysart at page 2, lines 3-7). The motivation

to combine Cukor, Reding, Seto et al with Dysart would have been to take the advantage of the well known lower rates and lower trafiic associated with nightly electronic transmision of data.

Applicant argues that the Board and the Examiner fail to consider arguments that distinguished the present invention over the cited prior art because it was determined that these points of distinction were not specifically recited in the claims. Applicant has cited page 12, first full paragraph of the BPAI Decision. Applicants then amend the claims to recite the capacity of local memories and the process of determining if a requested document is stored locally before requesting the data from a central site. In response, applicant's arguments that Cukor does not provide sufficient memory for storing documents or for long term storing is not persuasive. Cukor clearly teaches a storage for storing documents. There are no such assertion in Cukor itself of the size of their memory capacity. Absent a teaching is not an indication that a feature is non-obvious. Applicant is reminded that:

In re Bozek, 163 USPQ 545 (CCPA 1969) "Reference disclosure must be evaluated for all that it fairly suggests and not only for what is indicated as preferred." *In re Jacoby,* 135 USPQ 317 (CCPA 1962) "Problem cannot be approached on basis that workers in the art would know only what they could read in references; those skilled in radiator art must be presumed to know something about radiators apart from what references disclose" "it is immaterial that reference does not disclose specific function set forth in applicant's specification, since this is merely an additional attribute

possessed by reference structure which would be obvious to one skilled in the art in a

use which one skilled in the art, following teachings of prior art, might make of it"

A reference may be relied upon for all that it would have reasonably suggested to one

having ordinary skill in the art, including non-preferred embodiments.

Furthermore, Cukor et al at the time of filing, available memory capacity was

limited. Cukor does not specify the size or scanned documents or the storage capacities

of files or documents. Thus, Cukor would have taken great care in avoiding erasure of

important financial documents in their local memories. See column 6, lines 43-48.

Applicant's statement that "[A]t the beginning of the next day, those documents stored

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day's transaction. Moreover, Cukor states that "the remote stations include means 26

for communicating document images and related information back and forth with the

central processing site". (Column 7, second full paragraph). Thus, overwritten a day's

transactions would not have occurred in the system of Cukor.

As per applicant's argument that Cukor's system does not check to determine if

the requested document is stored locally before requesting the data from the central

processing site because a temporary file is erased the next day is not convincing

because it is not required that the memory is completely full for all transactions

occurring for a given day. Transactions are transmitted to a particular location where all

transaction processing can take place. See also the teachings of Seto et al.

5.   Claim 42 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cukor,

Reding and Seto et al as applied to claims 35 and 36 above, and further in view of

Wang.

Features recited in the instant claims were addressed in the prior Office actions,

BAPI and the Examiner's Answer. Applicant is referred to these prior actions. The

combination of Cukor, Reding and Seto et al does not explicitly teach adding images to

an existing folder nor transferring images between folders. These features were noted

to be taught by Wang. Incorporating Wang into the combination of Cukor, Reding and

Seto et al would have been obvious to the skilled artisan in order to simplify the storage

and retrieval of information.

Applicant argues that the Board and the Examiner fail to consider arguments that

distinguished the present invention over the cited prior art because it was determined

that these points of distinction were not specifically recited in the claims. Applicant has

cited page 12, first full paragraph of the BPAI Decision. Applicants then amend the

claims to recite the capacity of local memories and the process of determining if a

requested document is stored locally before requesting the data from a central site.

In response, applicant's arguments that Cukor does not provide sufficient memory for

storing documents or for long term storing is not persuasive. Cukor clearly teaches a

storage for storing documents. There are no such assertion in Cukor itself of the size

of their memory capacity. Absent a teaching is not an indication that a feature is non-

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radiator art must be presumed to know something about radiators apart from what

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set forth in applicant's specification, since this is merely an additional attribute

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use which one skilled in the art, following teachings of prior art, might make of it"

A reference may be relied upon for all that it would have reasonably suggested to one

having ordinary skill in the art, including non-preferred embodiments.

Furthermore, Cukor et al at the time of filing, available memory capacity was

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of files or documents. Thus, Cukor would have taken great care in avoiding erasure of

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for communicating document images and related information back and forth with the

central processing site". (Column 7, second full paragraph). Thus, overwritten a day's transactions would not have occurred in the system of Cukor.

As per applicant's argument that Cukor's system does not check to determine if the requested document is stored locally before requesting the data from the central processing site because a temporary file is erased the next day is not convincing because it is not required that the memory is completely full for all transactions occurring for a given day. Transactions are transmitted to a particular location where all transaction processing can take place.

Conclusion

6.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frantzy Poinvil whose telephone number is (703) 305-9779. The examiner can normally be reached on Monday-Thursday 7:00AM-5:30PM.

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9326 for before final communications, (703) 872-9327 for After Final communications and (703) 872-9325 for Customer Service communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

FP
February 20, 2004